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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION

MIDAS GREEN TECHNOLOGIES,)
LLC,)
Plaintiff,)
vs.) No.
RHODIUM ENTERPRISES,) 6:22-cv-00050-ADA
INC., et al.,)
Defendant.)
-----)

* * * C O N F I D E N T I A L * * *

February 19, 2024
9:40 a.m.

Deposition of JAMES H. LEE on
invalidity, held at the offices of K&L Gates
LLP, 599 Lexington Avenue, New York, New York,
pursuant to notice, before Laurie A. Collins,
a Registered Professional Reporter and Notary
Public of the State of New York.

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<p>1 Q. I'm asking about the entirety of your 2 definition. I focused you on the part that that I 3 was particularly -- 4 ATTORNEY THOMAS: Interested in. 5 Q. -- interested in. 09:48:15 6 ATTORNEY THOMAS: You didn't read all 7 of it. 8 A. It also says, Additional education can 9 compensate for less particular experience and vice 10 versa. 09:48:26 11 After reviewing it, I would not modify 12 the definition, no. 13 Q. Okay. And, by the way, I should also 14 just ask you: Is there anything in your report 15 that you're aware of before we start that you 09:48:34 16 would like to modify or correct? 17 A. I do have four corrections that I would 18 like to put forward -- 19 Q. Oh, okay. 20 A. -- from my report. 09:48:45 21 Q. All right. What is that piece of 22 paper? 23 A. This is a list of the four corrections. 24 Q. Okay. I'd like to get a photo of it. 25 ATTORNEY THOMAS: We'll give it to you 09:48:56 Page 10</p>	<p>1 through each appliance slot and therefore the 2014 2 Best publication is incapable of anticipating 3 Claim 1 under 35 USC at 102. 4 Q. Okay. 5 A. The next correction is at paragraph 274 09:50:26 6 in the third sentence. 7 Q. Okay. 8 A. Currently that sentence says, It is not 9 boiling dielectric fluid. The correct version 10 should say, It is not circulating dielectric 09:50:42 11 fluid. 12 Q. Okay. 13 A. The next correction should be an 14 omitted paragraph immediately after paragraph 370 15 on page 121. 09:51:02 16 Q. Okay. 17 A. And the additional paragraph should 18 read, It is my opinion that there is no motivation 19 for a POSITA to use the JP '758 patent nor the 20 Attlessey '419 patent in combination with any other 09:51:28 21 references cited by Dr. Ortega. 22 (Pause.) 23 A. And I can repeat any of that if it 24 would be helpful. 25 Q. I'm just writing. One moment. 09:52:26 Page 12</p>
<p>1 at a break. He'll read them into the record 2 now. We'll give you a copy. 3 ATTORNEY HALPERN: That would be great. 4 Thank you. 5 ATTORNEY THOMAS: Go ahead. 09:49:04 6 Do you want him to read it? 7 ATTORNEY HALPERN: Yes. 8 A. At -- 9 Q. Yes. 10 A. Are you ready for me to start? 09:49:11 11 Q. I'm ready. 12 A. Okay. It says at paragraph 258 the 13 last sentence currently says, Consequently, the 14 2014 Best publication does not disclose a plenum 15 positioned adjacent to the bottom of the tank 09:49:27 16 adapted to dispense the dielectric fluid 17 substantially uniformly upwardly through each 18 appliance slot and therefore the Best '463 patent 19 is incapable of anticipating Claim 1 under 35 USC 20 paragraph 102. 09:49:45 21 Now, the corrected version should read, 22 Consequently, the 2014 Best publication does not 23 disclose a plenum positioned adjacent to the 24 bottom of the tank adapted to dispense the 25 dielectric fluid substantially uniformly upwardly 09:50:02 Page 11</p>	<p>1 A. Okay. 2 (Pause.) 3 Q. Okay. 4 A. And then the fourth and last correction 5 that I'm currently aware of, the last sentence the 09:52:40 6 words "otherwise system does not work" should be 7 removed from the end of the sentence. But I want 8 to emphasize -- 9 Q. I don't know where you are. You didn't 10 say. 09:52:56 11 A. Oh, paragraph 382. I apologize. 12 Q. Okay. So what's the -- 13 A. So the words at the end of the sentence 14 "otherwise system does not work" should be removed 15 from the end of the sentence, but the footnote 09:53:19 16 should remain. 17 Q. Okay. All right. 18 A. And that is all the corrections I'm 19 currently aware of. 20 Q. Okay. Thank you. 09:53:29 21 ATTORNEY HALPERN: So this would be Lee 22 Exhibit 2. 23 ATTORNEY THOMAS: Lee Exhibit 2, for 24 the record -- for the record, Lee Exhibit 2 is 25 Exhibit 1 to the report. 09:54:52 Page 13</p>

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<p>1 automatically control inactive messaging systems 2 that were not operating properly. 3 Q. Okay. For both of those sentences you 4 cite to the deposition testimony of Mr. Boyd -- 5 correct? -- Footnotes 9 and 10? 02:45:17 6 A. Yes, that's correct. 7 Q. Was there information in there that 8 derived also from conversations with Mr. Boyd in 9 addition to his deposition testimony? 10 A. During a conversation with Mr. Boyd, we 02:45:39 11 did talk about the inventor's notebook, page 5. 12 We also talked about inventor's notebook page 4, 13 which does have a mention of -- I forget the exact 14 quote -- somehow water was going to be -- I think 15 rainwater was being recaptured for the external 02:45:59 16 coolers. 17 And so I did ask him if, you know, he 18 intended -- in his -- as he was conceiving of the 19 information on page 5 was he also considering a 20 secondary cooling system, and he pointed to page 02:46:21 21 4. He said, yes, definitely, you know, any 22 practical cooling system would need to have a 23 secondary cooling facility. 24 Q. Okay. But that's the secondary cooling 25 facility. There's no -- you didn't mention -- 02:46:41 Page 142</p>	<p>1 paragraphs 90 through 93? 2 A. Yes. 3 Q. Okay. 4 So you do not offer any opinion that 5 the control facility limitation is described on 02:48:24 6 page 5 of Mr. Boyd's inventor's notebook; correct? 7 I'm talking about like what you have 8 here. In your discussion from 90 to 93, 9 paragraphs 90 to 93 -- you can include 94, which 10 is kind of the ultimate opinion -- you don't offer 02:48:49 11 any opinions in paragraphs 90 to 94 that the 12 control facility limitation is described on page 5 13 of Mr. Boyd's inventor's notebook; correct? 14 A. In Section H I do not refer to page 5 15 of Mr. Boyd's notebook, no. 02:49:08 16 Q. And the control facility limitation 17 that you quote in heading H on page 32 is part of 18 the claimed invention; right? 19 A. Yes, it is. 20 Q. Okay. In light of that, do you wish to 02:49:23 21 revise your opinion, which is at page 73, 22 paragraph 24 -- 23 A. Page 73? 24 Q. Unless I somehow screwed this up, which 25 I'm fearing that I have. Okay. Sorry. I have an 02:49:44 Page 144</p>
<p>1 well, first of all, that is not cited in your 2 report; right? Page 4 is not cited here, of 3 Dr. -- in this section -- sorry. 4 In these paragraphs discussing control 5 facility, you don't cite -- as you already 02:46:56 6 testified, you don't cite any page of Mr. Boyd's 7 inventor's notebook? 8 A. Oh, sure -- of Section H? 9 Q. Yeah. 10 A. Okay. No, I do not. 02:47:11 11 Q. But you're referencing that Mr. Boyd 12 told you in conversation that he had in mind -- 13 well, I'm asking about a control facility. Are 14 you telling me he had in mind -- he told you in 15 conversation, in addition to the testimony you 02:47:33 16 cite here, at the time he had a control facility 17 in mind? 18 A. Yes, I believe in deposition he said it 19 would be something along the lines of any system 20 would require a control system. 02:47:48 21 Q. Okay. I'm just trying to establish 22 what you're relying on here. So you're relying on 23 his deposition testimony, and are you also relying 24 on conversations you had with him for your 25 opinions in Section H about limitation H, 02:47:59 Page 143</p>	<p>1 incorrect reference in there -- paragraph 73, page 2 24. Yes. Okay. 3 Yeah, do you wish to revise your 4 opinion at page 24, paragraph 73, that page 5 of 5 Mr. Boyd's inventor's notebook shows that 02:50:23 6 Mr. Boyd, as of March 12th, 2012, had a definite 7 and permanent idea of the complete and operative 8 invention as set out in the asserted claims, since 9 the complete invention includes the limitation H 10 and you've just testified that you don't point to 02:50:50 11 any support on page 5 for that limitation? 12 A. Can you repeat your question? 13 Q. Sure. Do you wish to revise your 14 opinion at page 24, paragraph 73, that page 5 of 15 Mr. Boyd's inventor's notebook shows that 02:51:13 16 Mr. Boyd, as of March 12th, 2012, had a definite 17 and permanent idea of the complete and operative 18 invention as set out in the asserted claims? 19 A. No. 20 Q. Okay. And so where does page 5 of the 02:51:28 21 inventor's notes talk about the control facility? 22 A. I would say in Note 3, which is U tubes 23 drain into a closed sump container for 24 recirculation through heat exchanger. Note that 25 the pump cannot drain the tank. 02:53:02 Page 145</p>

<p>1 I think this combined with the 2 deposition and conversations with Mr. Boyd clearly 3 shows that a control facility was in his mind when 4 he conceived of the concept of the -- what became 5 the '457 patent. 02:53:28 6 Q. So you did not cite this in this 7 discussion on page 5 -- correct? -- as I think you 8 already testified? 9 ATTORNEY THOMAS: I just want to 10 object. It's at page 25 -- he just read from 02:53:41 11 page 25 of his report. 12 ATTORNEY HALPERN: Yeah. No, I know. 13 But I asked him earlier if he had identified 14 in his discussion of the control facility 15 limitation anything supporting that as 02:54:00 16 disclosed on page 5, and he acknowledged that 17 he had not cited page 5 and that all the 18 materials that he was relying on were in that 19 section. 20 So now I've asked, well, what on page 5 02:54:12 21 supports that limitation. 22 Q. And you're pointing to this paragraph. 23 So the assertion that page 5 discloses the control 24 facility limitation is a new opinion that you're 25 offering? 02:54:38</p> <p>Page 146</p>	<p>1 the control facility limitation. 2 A. And you were asking specifically about 3 Section H. Am I not correct? 4 Q. Yeah, the control facility limitation. 5 A. In Section H I did not refer to it, 02:56:11 6 which was your question. So I answered your 7 question as stated I believe correctly. If I -- 8 if I did not, I will amend my answer. 9 Q. Okay. I asked you does this section 10 identify all the facts and evidence you considered 02:56:55 11 and relied on in forming that opinion, the opinion 12 that Mr. Boyd had conceived of the control 13 facility limitation as of March 14th, 2012. 14 I said does this section identify all 15 the facts and evidence you considered and relied 02:57:15 16 on in forming that opinion that the patent is 17 entitled to a priority date of March 14th, 2012. 18 And, I'm sorry, and then... 19 (Pause.) 20 Q. I said, So you do not offer any opinion 02:58:01 21 that the control facility limitation as described 22 on page 5 of Mr. Boyd's inventor's notebook. And 23 then it says correct. I think that was an answer, 24 but it's not showing as an answer on the real- 25 time, and then -- but I could be wrong. Just from 02:58:17</p> <p>Page 148</p>
<p>1 ATTORNEY THOMAS: Objection, 2 mischaracterizes his report. 3 ATTORNEY HALPERN: I'm asking. 4 A. If I recall correctly -- and if I'm 5 wrong, please point it out -- what you asked was 02:54:49 6 in Section H, which is a control facility adapted 7 to coordinate the operation of the primary and 8 secondary fluid circulation facility as a function 9 of the temperature of the dielectric fluid in the 10 tank, did I refer to page 5. And the answer to 02:55:04 11 that is yes. 12 Did I never respond or never cite page 13 5 as being considered for my opinion? The answer 14 to that would be yes, I did consider it, just not 15 in Section 8 -- H. 02:55:24 16 So I think it's a stretch to say 17 because it's not in Section H I didn't consider 18 it. 19 Q. I didn't ask if you considered it; I 20 asked if you cited it or relied on it -- 02:55:36 21 A. In Section H. 22 Q. Yes, as support. I asked you if you 23 cited or relied on page 5 of the inventor notes as 24 support for a disclosure as of -- or of -- sorry, 25 a support for invention as of March 14th, 2012, of 02:55:56</p> <p>Page 147</p>	<p>1 the rhythm of it. Maybe I'm wrong. Okay. 2 Then I asked, In your discussion from 3 90 to 93, paragraphs 90 to 93, you don't offer any 4 opinions in paragraphs 90 to 94 that the control 5 facility limitation is described on page 5 of 02:58:36 6 Mr. Boyd's inventor's notebook; correct? And you 7 answered, In Section H I do not refer to page 5 of 8 Mr. Boyd's notebook, no. 9 A. Which is a true statement. 10 Q. Okay. 02:58:48 11 A. If you look at all these different 12 paragraphs in Section H, there is no mention of 13 page 5. 14 Q. Okay. 15 A. I believe it isn't a stretch -- and let 02:58:55 16 me just be very clear -- I did refer to page 5 17 when making my opinion that there was a control 18 facility included. 19 Q. Where did you refer to page 5 in 20 support of that opinion? 02:59:08 21 A. It is right here on page 25. As I 22 said, in note 3. 23 Q. Page 25 is just (indicating). 24 A. It's a reproduction -- 25 Q. Right. 02:59:25</p> <p>Page 149</p>

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<p>1 Q. And why is it that you want to make 2 this clarification or correction to your report? 3 A. I think this more correctly expresses 4 the material considered in Section H. 5 ATTORNEY THOMAS: Okay. I have no 07:06:29 6 further questions. 7 ATTORNEY HALPERN: Okay. And not going 8 to ask a question about this, but I'm just 9 going to move to strike this. Obviously we 10 have to follow this up with a written motion 07:06:37 11 as an untimely opinion that goes outside the 12 scope of his report. I asked him questions 13 about it. He testified about it. You know, 14 that's part of the normal process. But this 15 is not. So move to strike. 07:06:48 16 ATTORNEY THOMAS: Okay. Motion denied. 17 Okay. We're done. 18 (Continued on following page.) 19 20 21 22 23 24 25</p> <p style="text-align: right;">Page 286</p>	<p>1 C E R T I F I C A T E 2 S T A T E O F N E W Y O R K) 3 : s s . 4 C O U N T Y O F N E W Y O R K) 5 6 I, LAURIE A. COLLINS, a Registered 7 Professional Reporter and Notary Public 8 within and for the State of New York, do 9 hereby certify: 10 That JAMES H. LEE, the witness whose 11 deposition is hereinbefore set forth, was 12 duly sworn by me and that such deposition 13 is a true record of the testimony given by 14 the witness. 15 I further certify that I am not 16 related to any of the parties to this 17 action by blood or marriage and that I am 18 in no way interested in the outcome of this 19 matter. 20 IN WITNESS WHEREOF, I have hereunto 21 set my hand this 21st day of February 2024. 22 23 24  25 LAURIE A. COLLINS, RPR</p> <p style="text-align: right;">Page 288</p>
<p>1 THE VIDEOGRAPHER: We're going off the 2 record at 7:07 p.m. This concludes today's 3 testimony given by Dr. James Lee. The total 4 number of media units used was eight and will 5 be retained by Veritext Legal Solutions. 07:07:10 6 Thank you. We're off the record. 7 (Time noted: 7:07 p.m.) 8 9 JAMES H. LEE 10 11 Subscribed and sworn to before me 12 this ____ day of _____ 2024. 13 14 _____ 15 16 17 18 19 20 21 22 23 24 25</p> <p style="text-align: right;">Page 287</p>	<p>1 ----- I N D E X ----- 2 3 WITNESS: EXAMINATION BY: PAGE 4 James H. Lee Attorney Halpern 5 5 6 ----- EXHIBITS ----- 7 LEE NO. DESCRIPTION PAGE 8 9 Exhibit 1, expert report of Lee 8 10 Exhibit 2, Exhibit 1 to expert report 14 11 of Lee 12 Exhibit 3, Exhibits 3 and 4 to expert 57 13 report of Lee 14 Exhibit 4, excerpted deposition 73 15 transcript of Sickmiller 16 Exhibit 5, press release 93 17 Exhibit 6, excerpted deposition 116 18 transcript of Boyd 19 Exhibit 7, pages 217 to 222 from 118 20 deposition transcript of Boyd 21 Exhibit 8, Exhibit 8 to deposition of 137 22 Boyd 23 Exhibit 9, errata to deposition 168 24 transcript of Boyd 25 Exhibit 10, pages 164 and 165 of 169</p> <p style="text-align: right;">Page 289</p>